

In the Supreme Court of the United States

Case No. 137

No. 137

THE TINKLEBERRY ARMS COMPANY

Petitioner

vs.

CLEVELAND STEEL PRODUCTS CORPORATION

Respondent.

PETITION FOR A WRIT OF HABEAS CORPUS

To the United States Circuit Court of Appeals

For the Sixth Circuit

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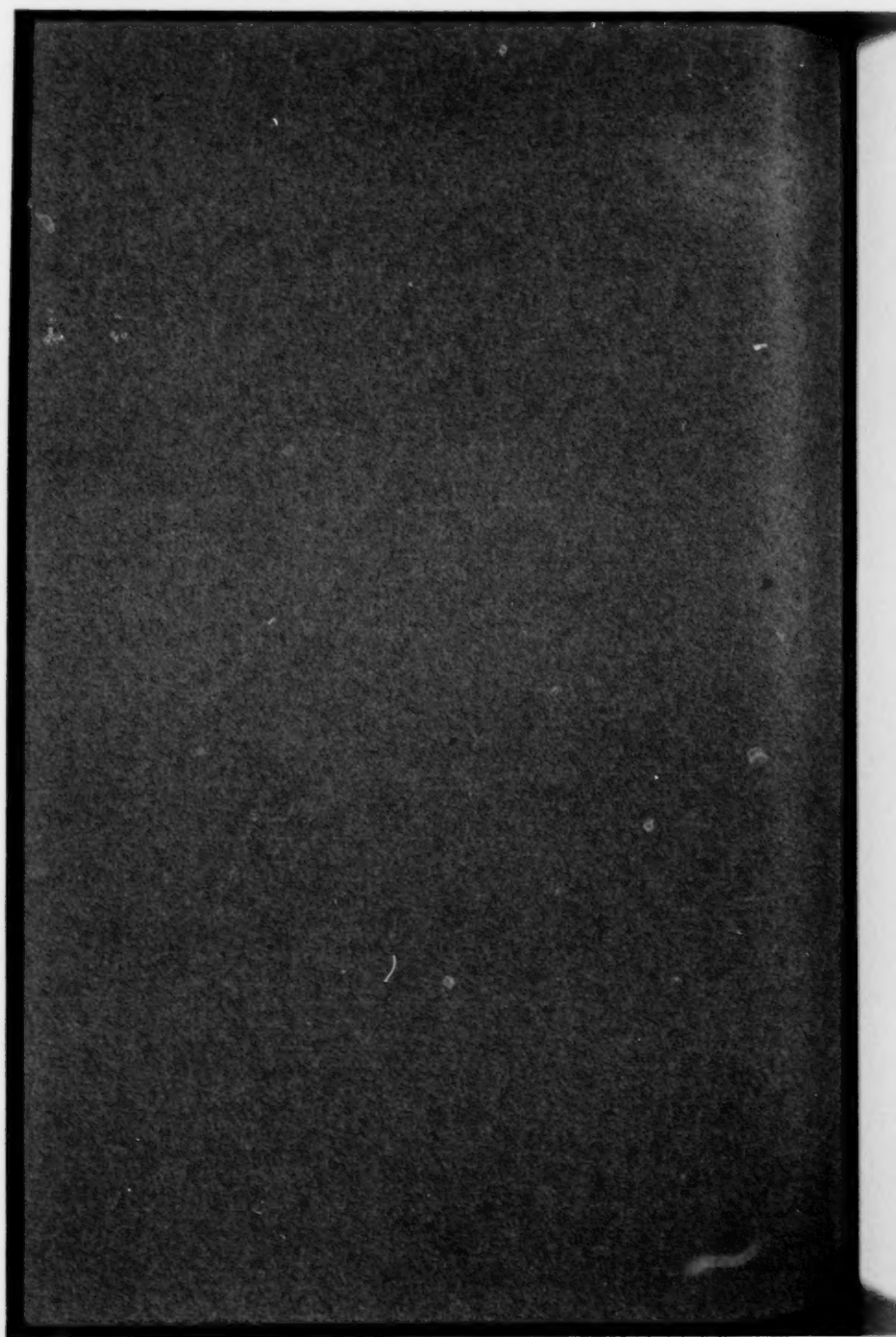
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INDEX.

PETITION FOR A WRIT OF CERTIORARI.....	1
A. Summary Statement of Matters Involved.....	2
B. Reasons Relied Upon for Allowance of the Writ..	4
BRIEF IN SUPPORT OF THE PETITION FOR CER- TIORARI	9
Statement of the Case.....	9
I. The Opinions of the Courts Below.....	9
II. Jurisdiction	9
III. The Issues	9
IV. Argument	10
Foreword	10
Confusion in the Patent Law and the Patent Practice	11
Disastrous Consequences of This Confusion:	
(A) Decline in decision favorable to the pat- entee almost to the vanishing point and to where the patent grant is no longer an incentive to invent.....	11
(B) Decline of 41½% in per capita issue of patents occurred in the United States between 1933 and 1943.....	13
(C) There was a decline of 54% in the filing of applications for United States patents in the Patent Office from 1930 to 1943 on a per capita basis.....	14
(D) Substantial decline in invention in the United States is conclusively estab- lished by these records.....	15
(E) History affirms these conclusions.....	17

The Cause at Bar and Its Fortunes Below:	
The Tribunals Below.....	19
(a) The Patent Office Tribunals.....	19
(b) The District Court.....	21
Invention and Mechanical Skill.....	21
Sufficiency of Disclosure.....	25
(c) The Opinion of the Court of Appeals....	27
“Insufficiency of Disclosure” in the First Patent	27
The Court of Appeals in Considering Non-Invention	30
Confusion in the Cause at Bar.....	33
This Court in Its Decision in Sinclair & Carroll vs. Interchemical Corporation	34
The Advance in the Instant Cause Which is “Beneficial to Society”.....	37
Is the Test of Invention versus Mechanical Skill Any More Difficult to Apply Than Any Other Factual Question?	38
Conclusion	40

TABLE OF AUTHORITIES.

Cases.

<i>Armstrong v. United Cork</i> , 107 Fed. (2) 37 (C. C. A. 3)	5, 7, 11
<i>Cawood Case</i> , 94 U. S. 695.....	28
<i>Chicago Steel v. Burnside</i> , 132 Fed. (2) 812 (C. C. A. 7) 5, 7	
<i>Cuno vs. Automatic</i> , 314 U. S. 84.....	34
<i>Diamond v. Consolidated</i> , 220 U. S. 428.....	38
<i>Downton vs. Yeager</i> , 108 U. S. 466.....	28
<i>Eames vs. Andrews</i> , 122 U. S. 40.....	28

<i>Expanded Metal vs. Bradford</i> , 214 U. S. 366.....	7, 22, 23, 25, 39
<i>Goodyear vs. Ray-O-Vac</i> , 321 U. S. 275....	7, 22, 23, 25, 32
<i>Grant vs. Raymond</i> , 6 Peters 218.....	17
<i>Keystone vs. Adams</i> , 151 U. S. 319.....	23
<i>Lever vs. Procter</i> , 139 Fed. (2) 633.....	10
<i>Libby-Owens vs. Celanese</i> , 135 Fed. (2) 138 (C. C. A. 6)	30
<i>Loom Co. vs. Higgins</i> , 105 U. S. 580.....	7
<i>McElrath v. Industrial Rayon</i> , 123 Fed. (2) 627.....	39
<i>Mineral Separations vs. Hyde</i> , 242 U. S. 261.....	27, 30
<i>Mumm vs. Decker</i> , 301 U. S. 168.....	20
<i>Paramount vs. Tri-Ergon</i> , 294 U. S. 464.....	23
<i>Patterson vs. Kentucky</i> , 97 U. S. 501.....	15
<i>Picard v. United Aircraft Corp.</i> , 2 Cir., 128 F. 2d 632	6
<i>Potts vs. Creager</i> , 155 U. S. 597.....	23
<i>Radio vs. Radio</i> , 293 U. S. 1.....	20
<i>Seymour vs. Osborne</i> , 11 Wallace, 516.....	28
<i>Shortell, In re</i> , 142 Fed. (2) 292 (C. C. & P. A.)....	6, 7, 11
<i>Sinclair & Carroll vs. Interchemical</i> , U. S. Sup. Ct., decided May 21, 1945.....	30, 34, 35, 36
<i>Smith v. Goodyear</i> , 93 U. S. 486.....	7, 24, 31
<i>Smith vs. Snow</i> , 294 U. S. 1.....	22
<i>Texas vs. U. S.</i> , 10 F. S. 198.....	20
<i>Trabon v. Dirkes</i> , 136 Fed. (2) 24 (C. C. A. 6).....	6, 7
<i>Triangle vs. National Electric</i> , 65 USPQ 197.....	10
<i>U. S. vs. Marks</i> , 32 F. S. 459.....	20
<i>Wahl vs. Andis</i> , 66 Fed. (2) 164 (C. C. A. 7).....	39
<i>Wolverine vs. Detroit Gasket</i> , 65 U. S. P. Q. 208.....	30

Text.

Walker on Patents, Deller Edition, pp. 270-272..... 28

Statute.

Judicial Code Section 240 (a), as amended by the Acts
of February 13, 1925; 28 U. S. Code, Section 347.. 9

In the Supreme Court of the United States

OCTOBER TERM, 1944.

No.

THE TIMKEN-DETROIT AXLE COMPANY,
Petitioner,

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit.

To the Honorable Harlan F. Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, The Timken-Detroit Axle Company, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the Judgment of that Court entered March 5, 1945 (Vol. II, p. 1071) in a suit for unpaid royalties and alleged infringement of three patents (Rehearing denied after corrections of the Opinion, April 13, 1945) affirming the decree of the District Court for the Northern District of Ohio, Eastern Division (Vol. II, R. p. 1061; 52 F. S. 317) and directing that the Bill of Complaint (R. p. 2) be dismissed on the infringement cause. Defendant was ordered to pay the unpaid royalties so that the claim is not presented in this Petition.

A transcript of the record in the case, including the proceedings of said Circuit Court of Appeals, has been furnished in accordance with the rules of this Court.

A.

SUMMARY STATEMENT OF MATTERS INVOLVED.

This cause included (a) a claim for unpaid royalties under a license and (b) a claim of patent infringement; each claim was based on the same defendant's construction. The three patents relied upon related to oil burners involving chemical, physical, fuel combustion and other problems and the solution thereof. Both Courts held infringement (defendant duplicated plaintiff's commercial construction). Both Courts decided the license issue in plaintiff's favor.

The Patent Office held the disclosure in each of the three patents to be sufficient and to comply with the Statutes. The District Court held all three disclosures insufficient and the Court of Appeals held the disclosure of the first patent insufficient.

The Patent Office held all three patents to disclose invention on the same art which was before the Courts, including the art selected by the defendant's expert, as the best art, which was fully discussed in the Patent Office in *ex parte* and *inter partes* proceedings.

The conclusions of the Patent Office were supported and affirmed by the evidence in the record proving the presence of objective tests on the basis of which the District Court found that there was a "problem," that the patentee made "a great contribution" to the solution of the problem, which was accepted by the public as a solution, accompanied by commercial success and the taking of the license by the defendant. The District Court was obliged to select features from not less than six and, in fact, as many as ten, different prior art devices to find the combinations in the claims, and hold lack of patentable invention. The District Court found that there had been a change in shape, size, dimensions, material and arrangement of parts.

On these subjects the District Court said (Vol. II, pp. 1063-1064):

"The evidence convinces the court **that there was a problem, that the plaintiff made a great contribution to the solution of the problem**, an improvement in oil burners that **was accepted by the public** and had commercial success. The defendant itself took a temporary license." (Emphasis ours throughout this brief unless otherwise indicated.)

and (Vol. II, p. 1065):

"True, as plaintiff says, 'there has been a change in *the shape and in the size and dimensions * * * and differences in the relation to each other of the parts,*'."

and the District Court found (Vol. II, p. 1067):

"8. *Some of the features of the claimed inventions are disclosed in the Heath patent, some in the Bird patent, some in the Kolva patent, some in the Braun patent, some in Exhibit DXM, and some in Exhibit DXN, and were to the extent of such disclosure anticipated by such patents.*"

* * * * *

"6. There was a problem and plaintiff made a contribution to the solution of the problem, an improvement in oil burners that was accepted by the public and had commercial success."

The evidence shows that the "great contribution to the solution of the problem" referred to by the District Court included production of a furnace which eliminated the destructive and dangerous explosions or reduced them to a negligible minimum which heated and cooled quickly, whose efficiency and durability were increased, whose carbon deposits were reduced, oil cracking eliminated, which could burn heavier and cheaper oils and in which the service was reduced.

The record of the Court of Appeals shows a tremendous decline in the sustaining of patents in recent years, as we show *post* (p. 12), which would influence, and we think dominate, the views of a District Judge and naturally lead him to such a conclusion in spite of the evidence and the established law to the contrary.

The Court of Appeals held the first patent to be insufficient in description and then said "if we are wrong" in this finding then we affirm "for other infirmities in patentability."

Among the errors in the opinion of the Court of Appeals were its rulings upon issues not before the Court requiring the Court to issue a special order thirty days subsequent to the filing of the Court's opinion, which corrected some, but not all, of these procedural errors (Vol. VI, pp. 57-58).

The questions presented before this Court are questions of law and appeals to this Court to resene the inventing public and the patent bar from the confusion which has resulted from misunderstandings of the opinions of this Court and which has resulted in a most deplorable and alarming decline in patent applications filed, patents granted and inventions made in the United States in the last ten or fifteen years, as shown by data and curves which we supply hereinafter.

B.

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT.

(1) Conflict and confusion among and between the rulings and opinions of the Court of Appeals, the District Court and the Patent Office on the same issues, including (A) "sufficiency of disclosure" and (B) "invention or mechanical skill" over the same prior art as was before the Patent Office.

(2) Confusion among all patent Tribunals below regarding such questions as "invention and mechanical skill" and "sufficiency of disclosure" which has arisen since the institution of certain alleged "doctrinal trends," including "standards of invention" and "sufficiency of disclosure," and which has resulted in a decline of 54% in the per capita applications for patents in the United States between 1930 and 1943, a decline in patents issued in the United States of 41½% per capita between 1933 and 1943, a decline in Court adjudications favorable to inventors, and

consequent parallel declines in the making of inventions in the United States which has, and is, reflected by concern and alarm in the public press all over the United States.

(3) General lack of uniformity of decision among the patent Tribunals below on such subjects as "invention and mechanical skill" and "sufficiency of disclosure" resulting from these so-called "doctrinal trends," resulting from alleged changes in standards of invention and sufficiency of disclosure which has resulted in a wide variation in the views of the Courts of Appeals in different Circuits on this subject varying as follows: (a) there has been such a change,* (b) there has not been such a change,** and (c)

* In *Armstrong v. United Cork*, *post*, Judge Clark, speaking for the Third Circuit Court of Appeals, said (p. 37):

"The Supreme Court's standard of invention (that shifting fact question) can well be thought of as the target and the efforts of the lower courts to hit it proportionately subject to the law of probable error. The high court has in recent years moved that target-standard back.

* * * * *

"We, therefore, express to them" (the inventors) "our regret for 'the sins of the past.'"

In *Chicago Steel v. Burnside Steel*, *post*, Judge Evans, speaking for the Seventh Circuit Court of Appeals, said (pp. 816-817):

"While this digression may not clarify the test by which invention should be measured, it may serve to reaffirm the recognized standards which throughout the past century have been applied by courts, with some degree of safety and satisfaction. *They are under severe attack today, and this discussion is to emphasize the soundness of the standards which have been applied when considering the validity of patents.*

* * * * *

"The test of 'flash of genius' has been applied to curtail the field of patentable discovery and to eliminate from the protection of patents, all products (even though they came from the superior mind of genius) which were, nevertheless, the product of prolonged study and step by step advance. *In short, it would eliminate nearly all the advances of history, in science, and in the field of mechanics.*

* * * * *

(Continued on next page.)

if there has been such a change, what is it, and where is the present anchorage,† as exemplified by such statements

(Continued from preceding page.)

"The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. *The Federal decisions covering a century contain many to the effect that it is the fact of accomplishment,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned.*"

In the case of *Picard v. United Aircraft Corp.*, 2 Cir., 128 F. 2d 632, 636, the court said:

"We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize **'a pronounced new doctrinal trend'** which it is our 'duty, cautiously to be sure, to follow, not to resist'."

•• In its decision in *In Re Shortell*, *supra*, the Court of Customs and Patent Appeals said (p. 296):

"While recognizing, of course, that it is the duty of this court to follow the law as declared by the Supreme Court, *we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention.*

"In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. It seems clear to us that the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation.

"It follows, from the foregoing, that until Congress shall otherwise legislate, or the Supreme Court shall otherwise specifically hold, this court will continue to hold that if a process or thing constitutes patentable subject matter, is new and useful, and the process performed or thing produced would not be obvious to one skilled in the art, invention should be presumed and a patent may properly issue therefor."

† In *Trabon v. Dirkes*, *post*, Judge Simons said (p. 28):

"Whether in the great inventions adjudged patentable in the past the inventive concept arrived with the blinding suddenness of the lightning's flash, or from 'the projection of the imagination into the realms of the unknown,' or whether they were the product of painful and laborious experimentation apparently condemned as indicia of invention in *Picard v. Aircraft Corp.*, 2 Cir., 128 F. 2d 632, *we do not know.* Some were

as we quote *supra*, in the accompanying footnotes from such decisions as *Armstrong v. United Cork*, 107 Fed. (2) 37 (C. C. A. 3) and *In re Shortell*, 142 Fed. (2) 292 (C. C. & P. A.), *Chicago Steel v. Burnside*, 132 Fed. (2) 812, 816-818 (C. C. A. 7), and *Trabon v. Dirkes*, 136 Fed. (2) 24 (C. C. A. 6). These are typical; the number is legion.

(4) The decision of the Court of Appeals below is at variance with this Court's decisions in numerous cases ancient, intermediate and current, and ranging from the recent case of *Goodyear vs. Ray-O-Vac*, 321 U. S. 275 back to and beyond *Smith v. Goodyear*, 93 U. S. 486 on each of the following subjects:

(a) Invention is present in a new combination of elements where new advantages are realized, where the public is benefited and where there is some substantial innovations, especially when supported by objective tests. (*Loom Co. vs. Higgins*, 105 U. S. 580; *Expanded Metal vs. Bradford*, 214 U. S. 366, 381.)

(b) There is invention in change of material when new and important advantages are realized, especially when supported by the presence of objective tests. (*Smith vs. Goodyear*, 93 U. S. 486; *Goodyear v. Ray-O-Vac*, 321 U. S. 275 (See 45 F. S. 927, 931).)

Respectfully submitted,

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undoubtedly the product of accidental discovery. At least so thinks Dr. Kettering, Chairman of the National Patents Planning Commission. Certain it is that Edison placed little confidence in inspiration when he defined genius as '2% inspiration and 98% perspiration.' "